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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,559	03/22/2000	Randy M. Berka	5849.200-US	6980

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EXAMINER	
BRUSCA, JOHN S	

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/533,559	Applicant(s) BERKA ET AL.	
	Examiner John S. Brusca	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *12 May 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to. *none*.

   Claim(s) rejected: *103-110*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____

10. ☐ Other: _____

John S. Brusca
Primary Examiner
Art Unit: 1631

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 90-102 under 35 U.S.C. 112, first paragraph for lack of written description.

Continuation of 5. does NOT place the application in condition for allowance because: the amendment cancels all pending claims and adds new claims 103-110. Proposed new claims 103-110 would not be rejected under 35 U.S.C. 112, first paragraph for lack of written description, as noted above. However proposed new claims 103-110 would, if entered, continue to be rejected for lack of patentable utility under 35 U.S.C 101 and 112, first paragraph for reasons of record. The applicants arguments are not persuasive. The applicants state that example 16 on pages 357-358 demonstrates how to use the claimed invention. Example 16 refers to measurement of polynucleotide sample hybridization to a microarray comprising EST probes of Fusarium venenatum, while the claims are drawn to use of a microarray comprising EST probes of Aspergillus oryzae. The applicants state that measuring the ability of a polynucleotide sample to hybridize to th probes on a microarray of Aspergillus oryzae allows for measurement of expression profiles in the sample, and further allows comparison of samples prepared from cells grown under different conditions to determine the effect of the condition on the expression profile of the EST sequences. Because the function of the EST-linked genes has not been clearly established, and because it is not known what differences of expression would be seen if the claimed method were performed, there would be further experimentation required on the claimed method to establish whether useful information would be produced by the claimed method. This is not consistent with a substantial patentable utility.